

The Honorable Robert S. Lasnik

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WASHINGTON**

UNIVERSAL LIFE CHURCH MONASTERY
STOREHOUSE, a Washington non-profit
corporation,

Plaintiff,

v.

MAURICE KING; LEWIS KING; GLEN
YOSHIOKA; DYLAN WALL; SARA WHITE;
and AMERICAN MARRIAGE MINISTRIES, a
Washington non-profit corporation,

Defendants.

AMERICAN MARRIAGE MINISTRIES, a

Counter-Claimant and
Third-Party Plaintiff,

v.

UNIVERSAL LIFE CHURCH MONASTERY
STOREHOUSE; UNIVERSAL LIFE CHURCH
MONASTERY STOREHOUSE, INC.,

Counter-Defendant and
Third-Party Defendants.

Case No. 2:19-cv-00301-RSL

**[PROPOSED] ORDER GRANTING
PLAINTIFF'S MOTION FOR
PARTIAL SUMMARY JUDGMENT**

[Proposed] Order Granting Plaintiff's
Motion for Partial Summary Judgment– 0
2:19-cv-00301-RSL

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1 This matter comes before the Court upon Plaintiff Universal Life Church Monastery
 2 Storehouse's ("ULC Monastery") Motion for Partial Summary Judgment (ECF No. ____). The Court
 3 has considered that Motion, the supporting Declarations of Michael P. Matesky, II (ECF No. ____),
 4 George Freeman, and Brian Wozeniak (ECF No. ____), and exhibits thereto; Defendant American
 5 Marriage Ministries' ("AMM") Opposition / Response (ECF No. ____); and ULC Monastery's
 6 Reply (ECF No. ____). For the following reasons, the Motion is hereby GRANTED.
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9 1. On March 26, 2019, AMM filed seven counterclaims: (1) Trademark Infringement
 10 under the Lanham Act, 15 U.S.C. § 1114; (2) Cybersquatting under the Anti-Cybersquatting
 11 Consumer Protection Act ("ACPA"), 15 U.S.C. § 1125(d); (3) False Advertising and Commercial
 12 Disparagement under the Lanham Act, 15 U.S.C. § 1125(a); (4) Violation of the Washington
 13 Consumer Protection Act ("WCPA"), RCW 19.86; (5) common law Defamation *Per Se*; (6)
 14 common law Trade Libel; and (7) common law Trademark Infringement. (ECF Nos. 6, 28)
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16 2. The pleadings and undisputed facts show that AMM's WCPA, defamation, trade
 17 libel, and common law trademark infringement counterclaims are barred by the applicable statutes
 18 of limitations.

19 3. "A statute of limitation bars plaintiff from bringing an already accrued claim after
 20 a specified period of time." *Rice v. Dow Chemical Co.*, 124 Wn.2d 205, 211 (Wash. 1994). A claim
 21 generally accrues when the underlying actions giving rise to the claim occur. *White v. Johns-*
 22 *Mansville Corp.*, 103 Wash.2d 344, 348 (1985).
 23

24 4. AMM's counterclaims for defamation and trade libel are subject to a two-year
 25 limitations period. RCW 4.16.100(1); see *Eastwood v. Cascade Broad. Co.*, 106 Wn.2d 466, 722
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1 P.2d 1295 (1986); *see also* *GOLO, LLC v. HighYa, LLC*, 310 F. Supp. 3d 499, 507 (E.D. Pa. 2018);
2 *Enigma Software Group USA, LLC v. Bleeping Computer LLC*, 194 F. Supp. 3d 263, 276
3 (S.D.N.Y. 2016) (same).

4 5. AMM's counterclaims for defamation and trade libel accrued on November 17,
5 2014, when AMM alleges ULC Monastery began publishing false and defamatory statements
6 regarding AMM on the Americanmarriageministries.com site. ECF No. 28, ¶¶ 82, 90-93, 173,
7 178. There is no evidence that such publication was concealed, AMM was aware of the
8 Americanmarriageministries.com site, and should have known of such publication in the exercise
9 of reasonable diligence. In any case, AMM's counterclaims for defamation and trade libel accrued
10 no later than December 26, 2014, by which date AMM testified it had actual knowledge of the
11 publication of allegedly false and defamatory statements on Americanmarriageministries.com.
12 Matesky Decl. Ex. B at 163:3-9. Because AMM filed its defamation and trade libel counterclaims
13 over two years after they accrued, they are barred by the statute of limitations.
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15 6. AMM's counterclaim for violation of the WCPA is subject to a two-year
16 limitations period to the extent it arises from the same acts underlying AMM's defamation and
17 trade libel claims, and subject to a three-year limitations period to the extent it arises from the same
18 acts underlying AMM's common law trademark infringement counterclaim. *See Killian v. Seattle*
19 *Pub. Sch.*, 189 Wn.2d 447, 455 (2017) (plaintiff's WCPA claim subsumed by "duty of fair
20 representation" claim, subject to 2 year limitations period); *see also Eastwood*, 106 Wn.2d at 469
21 (two-year limitations period for defamation applied to false light publicity claim based on same
22 acts).
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1 7. AMM's counterclaim for violation of the WCPA accrued no later than December
2 26, 2014. As discussed above, by that time, AMM had actual knowledge of the acts underlying
3 its WCPA claim, which are the same acts underlying its defamation, trade libel, and common law
4 trademark infringement claims. Because AMM filed its WCPA counterclaim over four years after
5 it accrued, it is barred by the statute of limitations. The same result would obtain under RCW
6 19.86.120.
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8 8. AMM's three federal counterclaims, Lanham Act trademark infringement,
9 violation of the Anti-Cybersquatting Consumer Protection Act, and Lanham Act False Advertising
10 and Commercial Disparagement, are barred by laches.

11 9. Laches applies where (1) the claimant unreasonably delayed in filing suit, and (2)
12 such delay caused the defendant to suffer some prejudice. *Jarrow Formulas, Inc. v. Nutrition*
13 *Now, Inc.*, 304 F.3d 829, 835 (9th Cir. 2002). Because AMM waited beyond the analogous
14 limitations period to file its federal counterclaims, laches is presumed to apply. *Id.* at 837-38.
15 AMM has not come forth with evidence sufficient to meet its burden to disprove the elements of
16 laches.
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18 10. AMM's delay in bringing suit beyond the analogous limitations periods is
19 presumptively unreasonable, and AMM's own testimony shows that the reason for its delay was
20 simply to avoid interacting with ULC Monastery. This is insufficient justification. *See Grupo*
21 *Gigante SA De CV v. Dallo & Co., Inc.*, 391 F.3d 1088, 1102 (9th Cir. 2004) ("Companies
22 expecting judicial enforcement of their marks must conduct an effective policing effort.")
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24 11. AMM's delay in bringing suit presumptively caused prejudice to ULC Monastery,
25 and AMM has not come forth with sufficient evidence to disprove such prejudice.
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1 12. AMM’s own claims and testimony show that ULC Monastery suffered prejudice in
2 increased potential liability that would not have been at issue if AMM had filed suit promptly. *See*
3 *Whittaker Corp. v. Execuair Corp.*, 736 F.2d 1341, 1347 (9th Cir. 1984).

4 13. The undisputed evidence shows that ULC Monastery’s ability to muster evidence
5 to defend itself against AMM’s claims of bad faith intent, damages, and the validity of AMM’s
6 claimed “American Marriage Ministries” trademark has also been prejudiced by AMM’s delay in
7 filing suit. *See Jackson v. Axton*, 25 F.3d 884, 889 (9th Cir. 1994).

8 14. Summary judgment dismissing AMM’s counterclaims based on alleged misuse of
9 AMM’s claimed “American Marriage Ministries” trademark—Lanham Act and common law
10 trademark infringement, violation of the ACPA, and Lanham Act False Advertising and
11 Commercial Disparagement—is also appropriate, because AMM has not come forth with evidence
12 sufficient to establish rights in its claimed “American Marriage Ministries” mark.
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14 15. It is AMM’s burden to prove validity of its claimed “American Marriage
15 Ministries” mark. *Tie Tech, Inc. v. Kinedyne Corp.*, 296 F.3d 778, 783 (9th Cir. 2002). AMM’s
16 Registration No. 4887624 for the claimed “American Marriage Ministries” mark constitutes prima
17 facie evidence of validity and distinctiveness, but only as of the date of registration: January 19,
18 2016. *Id.*; *Zinner v. Olenych*, 108 F. Supp. 3d 369, 383 (E.D. Va. 2015).
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20 16. The survey evidence of Rhonda Harper showing that the claimed “American
21 Marriage Ministries” mark has not obtained secondary meaning is sufficient to pierce any
22 presumption of validity, placing the burden back on AMM to prove distinctiveness and validity.
23 *Tie Tech*, 296 F.3d at 783. This burden requires an especially strong showing of secondary
24 meaning, because the claimed “American Marriage Ministries” mark is highly descriptive of
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1 AMM's services. *See Filipino Yellow Pages v. Asian Journal*, 198 F.3d 1143, 1151 (9th Cir.
2 1999). AMM has not come forth with evidence sufficient to meet this burden.

3 17. AMM was required to show that its claimed "American Marriage Ministries" mark
4 was distinctive at the time the alleged infringement and cybersquatting began. *See Converse, Inc.*
5 *v. USITC*, 909 F.3d 1110, 1116-17 (Fed. Cir. 2018); *GoPets Ltd. v. Hise*, 657 F.3d 1024, 1030 (9th
6 Cir. 2011). The alleged infringement and cybersquatting began no later than July 28, 2011. AMM
7 itself claimed that the alleged infringement began no later than July 12, 2014. AMM did not come
8 forth with sufficient evidence to meet this burden.

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10 18. Summary judgment dismissing AMM's counterclaims based on alleged misuse of
11 AMM's claimed "American Marriage Ministries" trademark—Lanham Act and common law
12 trademark infringement, violation of the ACPA, and Lanham Act False Advertising and
13 Commercial Disparagement—is also appropriate, because the undisputed facts show that ULC
14 Monastery's alleged misuse is non-infringing.

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16 19. The Lanham Act does not prohibit use of a trademark as a domain name to publish
17 a commentary site regarding the claimant, without selling goods and services on the site. *See*
18 *Bosley Medical Institute, Inc. v. Kremer*, 402 F.3d 672, 676 (9th Cir. 2005). Accordingly, AMM's
19 trademark claims based on the Americanmarriageministries.com site fail as a matter of law.

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21 20. The undisputed facts show that ULC Monastery use of the claimed "American
22 Marriage Ministries" mark on the Americanmarriageministries.com site constitutes nominative
23 fair use. The undisputed facts show that (1) AMM is not readily identifiable without use of the
24 claimed "American Marriage Ministries" mark, (2) ULC Monastery uses only so much of the
25 claimed mark as is reasonably necessary, and (3) such use did not suggest sponsorship or
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1 endorsement. Accordingly, ULC Monastery's use of the claimed "American Marriage Ministries"
2 mark on the Americanmarriageministries.com site constitutes nominative fair use as a matter of
3 law. *Applied Underwriters, Inc. v. Lichtenegger*, 913 F.3d 884 (9th Cir. 2019).

4 21. The undisputed facts show that ULC Monastery's use of the words "American
5 marriage ministries" on the GetOrdained.org and ULC.org sites is classic or descriptive fair use.
6 The undisputed facts show that ULC Monastery (1) is not using the words "American marriage
7 ministries" as a trademark, (2) uses the term only to describe the services of U.S.-based marriage
8 ministries, and (3) uses the term fairly and in good faith. Accordingly, ULC Monastery's use of
9 the words "American marriage ministries" on the GetOrdained.org and ULC.org sites constitutes
10 fair use as a matter of law. *Bell v. Harley Davidson Motor Co.*, 539 F.Supp.2d 1249, 1257 (S.D.
11 Cal. 2008).

12 22. AMM has not come forth with evidence on which a reasonable jury could find that
13 a "reasonably prudent" visitor to Americanmarriageministries.com, GetOrdained.org, or ULC.org
14 is likely to be confused as to source, sponsorship, or affiliation between AMM and ULC
15 Monastery, due to ULC Monastery's use of the words "American marriage ministries" on such
16 sites.

17 Therefore, it is hereby ORDERED that Plaintiff's Partial Motion for Summary Judgment
18 is GRANTED, and each of AMM's counterclaims is dismissed.

19 DATED this ____ day of _____, 2020.

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THE HONORABLE ROBERT S. LASNIK
United States District Judge

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3 **Presented by:**
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5 DATED: 6/16/2020

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